

REMARKS

STATUS OF THE CLAIMS

[0004] Claims 1, 3-6, 8, 10-18, 20, 21, and 23 remain in the case. Claims 1, 3-6, 8, 10-18, 20, 21, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 7,080,104 to Ring et al. [hereinafter “*Ring*”] in view of U.S. Patent Application No. 2003/0158860 to Caughey [hereinafter “*Caughey*”] and U.S. Patent No. 7,007,041 to Multer, et al. [hereinafter “*Multer*”]. Claims 1, 3, 8, 10, 16, 17, and 20 have been amended. No new claims have been added. No new matter has been added. The amendments are supported in paragraphs 8, 10-11, 28, 31-32, and 34-35 of the Specification.

RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

[0005] The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 459 (1966) sets forth the factual inquiry necessary to determine obviousness. The Examiner must: determine the scope and contents of the prior art; determine the differences between the prior art and the claims at issue; resolve the level of ordinary skill in the pertinent art; and consider objective evidence present in the application indicative of obviousness or non-obviousness.

[0006] Applicants respectfully assert that the Office Action fails to establish a *prima facie* case of obviousness in light of the amended claims. First, not all elements of the amended claims are taught or suggested in the art of record, and second, the art of record teaches away from the Applicants’ claimed invention. Applicants respectfully submit that *Ring*, *Caughey*, and *Mulder* do not teach the validation module of the amended claims at

issue, and further that *Ring*, and *Mulder* both teach away from the inclusion of a validation module, and from user interaction in general.

[0007] To highlight the differences between the present invention and the cited prior art, as mandated by *Graham*, a summary of the claimed invention and of the prior art may be useful. Generally, the claimed invention seeks to overcome problems of the prior art associated with creating an interactive messaging contact list for a user. Application at ¶¶ 2-5. As amended, Applicants' claimed invention solves these problems by retrieving contact information from a user's computer, validating that information both with the user and with an interactive messaging server, and inserting the validated information into an interactive messaging contact list. *Id.* at ¶ 6-7.

[0008] More specifically, a retrieval module retrieves contact information of online contacts from a plurality of contact sources on a user's computer. *Id.* at ¶ 7, 26-28, 30, 34. A validation module **verifies** with a messaging server which of the online contacts correspond to **valid users of an interactive messaging service** provided by the messaging server, **interactively prompts the user during a single online session** to accept or reject the contact information for each valid user, and **provides validated contact information**. *Id.* at ¶ 7-11, 28, 31-32, 35. An insertion module adds the validated contact information to an interactive messaging contact list. *Id.* at ¶ 7-9, 28, 31-32, 35.

[0009] By interactively prompting a user to resolve conflicts, the present invention provides a user with significant control over the compilation process of the user's contact list, and which of the user's contacts are added to the contact list, particularly when combining contact information from multiple lists. The invention contemplates real-time interactive

input from the user. The claims have been previously and presently amended to make this point clear.

[0010] Additionally, by **validating each online user with a messaging server** to determine which of the online contacts correspond to valid users of an **interactive messaging service provided by the messaging server**, and presenting **valid users** to the user to accept or reject, the interactive messaging contact list will automatically comprise valid users of the messaging service, thus increasing the utility of the interactive messaging contact list and of the claimed invention. Independent Claims 1, 8, 16, 17, and 20 have been amended to emphasize this point, which is supported in at least paragraphs 8, 10-11, 28, 31-32, and 34-35 of the Application.

Ring

[0011] *Ring*, in general, teaches synchronizing data folders between layers of folders or between folders on a network. *Ring* at Title, Abstract. *Ring* teaches synchronization that is automatic, and repeatedly teaches away from user intervention or interaction. *Id.* at column 3, lines 26-32; column 4, lines 61-65; columns 6, lines 11-15. For example, in lines 27-32 of column 3, *Ring* teaches “synchroniz[ing] data... with nominal or no need for user intervention” as well as “merg[ing] data... with nominal or no need for user intervention.” Instead of resolving conflicts interactively with a user, or customizing the synchronization, *Ring* teaches automatically resolving conflicts without user input, or merely informing the user of a conflict by email. *Id.* at column 19, line 61 – column 20, line 2.

Caughey

[0012] *Caughey*, in general, teaches retrieving updated contact information directly from a new contact, or from a client application running on the system of the new contact. *Caughey* at ¶¶ 45-47. *Caughey* teaches that contacts can be categorized as “one of a personal contact, a business contact, a ‘good’ contact, and a ‘bad’ contact” but is silent on verifying whether online contacts are valid users of an interactive messaging service. *Caughey* at ¶ 49. *Caughey* does not prompt a user to interactively select which new contacts to add, but instead allows the new contacts themselves to manually decide whether to “accept or decline the request.” *Caughey* at ¶ 46.

Multer

[0013] *Multer*, in general, teaches the synchronization and transference of data between two systems or devices. *Multer* at Abstract, column 1, lines 20-24. *Multer* teaches synchronizing data across multiple independent systems or devices using a difference engine so that data that has changed will be transferred. *Id.* at column 5, lines 36-56. *Multer* teaches that prior art synchronization systems are inefficient, because they “require interaction by the user” “at some level.” *Id.* at column 2, lines 46-51.

[0014] Additionally, both *Ring* and *Multer* clearly teach away from real-time user interaction as described in the claims at issue, teaching the user interaction should be minimized. *Multer* states in a list of **inefficiencies in the prior art** that systems that synchronize data over direct cable connections “require interaction by the user” “at some level,” likely referencing the need for a user to manually plug in a cable. As described

above, *Ring*, repeatedly teaches away from user intervention or interaction, and clearly states the goal of “nominal or no” user interaction. *Ring* at column 3, lines 26-32; column 4, lines 61-65; columns 6, lines 11-15. When user interaction is necessary, *Ring* teaches merely informing the user of a conflict by email, clearly minimizing any user interaction. *Id.* at column 19, line 61 – column 20, line 2.

[0015] Applicants respectfully submit that the teachings of *Caughey* do not read on the claimed invention. As amended, the claims at issue clearly state that the validation module uses a two step process to provide validated contact information. Claim 1 states that the validation module “**verifies with a messaging server** which of the online contacts correspond to valid users of an interactive messaging service provided by the messaging server.” Claim 1 further states that the validation module “**interactively prompts the user** during a single online session to accept or reject the contact information for each valid user.” As suggested by the Examiner in the telephone interview, the present amendments clarify that the user is a user of the computer on which the online contacts are stored, and is not a new contact. *Caughey*, in direct contrast to the claims at issue, is silent on both validation steps performed by the validation module, focusing instead on allowing new contacts themselves to “accept or decline” electronic messaging requests. *Caughey* at ¶ 46. *Caughey* focuses exclusively on the actions of new contacts and client applications running on a system of the new contact and does not teach the validation module of the claims at issue. *Id.* at ¶¶ 45-47.

[0016] The Supreme Court, in *KSR Int’l Co. v. Teleflex Inc.*, stated that “when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR Int’l Co. v. Teleflex Inc.*,

550 U.S. ____, 82 USPQ2d 1385, 1395 (2007). Applicants submit that the cited art references do not teach the validation module of Applicants' amended Claim 1 and similar limitations in independent Claims 8, 16, 17, and 20 that **verify with a messaging server** which online users are **valid users**, and further **interactively prompt the user** to accept or reject each valid user. Applicants further submit that even if *Caughey* did teach the validation module of the claims at issue, one of ordinary skill in the art would not combine *Caughey* with *Ring* and *Multer* because the references clearly teach away from the level of user interaction contemplated by the claims at issue, which is clear evidence of nonobviousness under *KSR*.

[0017] Applicants respectfully assert that Claim 1 is in condition for allowance. Similarly, Applicants assert that the arguments in favor of Claim 1 are equally applicable to Claims 8, 16, 17, and 20, which are in condition for allowance. Claims 3-6, 10-15, 18, 21, and 23 depend on Claim 1, 8, 16, 17, and 20. Because the invention of Claims 1, 8, 16, 17, and 20 are not obvious in relation to *Ring*, *Caughey*, and *Multer*, the Applicants respectfully assert that Claims 3-6, 10-15, 18, 21, and 23 are similarly in condition for allowance because they depend from allowable claims. See *in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

[0018] Applicants have presently amended Claims 1, 3, 8, 10, 16, 17, and 20. Applicants are not conceding in this application that those claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution of allowable subject matter. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications.

[0019] Should additional information be required, the Examiner is respectfully asked to notify the Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

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